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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,869	02/12/2002	Hiroshi Sasaki	Q68152	2417
23373	7590	01/08/2004		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037			EXAMINER SELLERS, ROBERT E	
			ART UNIT 1712	PAPER NUMBER

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/072,869

Applicant(s)

SASAKI ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10, 12, 14, 15, 17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

The election of Group I in the non-Final rejection filed November 10, 2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 11 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Claims 6-8 and 13 are withdrawn as being directed to non-elected species. The elections were made **without** traverse in the non-Final rejection filed November 10, 2003.

The 35 U.S.C. 112, first paragraph, rejection is withdrawn since the chemical names for EKP-206 and EKP-207 and photo-latent cationic initiator 2074 have been inserted into pages 13 and 15 of the specification, respectively.

The 35 U.S.C. 102(a) rejection over the Polymer Preprints article by Sasaki is rescinded due to the establishment of the priority date of February 13, 2001 for Japanese application no. 2001-34812 based on the English translation filed November 10, 2003 which antedates the publication date of August 26-30, 2001 for the Sasaki article according to page 2 of the article attached to the remarks of the amendment filed November 10, 2003.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 5, 9, 14, 15, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT Publication No. WO 00/63272.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the PCT publication.

The rejections are maintained for the reasons of record set forth in the previous Office action. The arguments filed November 10, 2003 have been considered but are unpersuasive.

There are no claimed limitations to independent claims 1 and 20 requiring the composition to be homogeneous, nor is there any enablement in the specification therefor. The claims do not necessitate the solid resin (B) being a tackifier as described on page 16, lines 14 and 21-23 of the specification.

The elastomer particles of the PCT publication possesses a softening point of at least 40°C and is compatible with the oxetane and alicyclic diepoxides since a homogeneous liquid mixture is obtained (page 38, line 26 to page 39, line 3).

Claims 1-5, 9, 10, 12, 14, 15, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent No. 848,294.

The rejections are maintained for the reasons of record set forth in the previous Office action. The arguments filed November 10, 2003 have been considered but are unpersuasive.

One skilled in the art would acknowledge the inherent characteristic in the petroleum resin of the European patent of exhibiting good adhesion as confirmed by Japanese patent nos. 9-40670 and 9-328651.

The comparison (page 25, Table 1 and Tables 2 and 3 on pages 28-29) between Example 1 containing a mono-oxetane, an epoxidized polyisoprene and poly(ethylene-butylene) block copolymer, and a hydrogenated petroleum resin; and Comparative Example 1 with the same components except for the absence of the hydrogenated petroleum resin is not commensurate in scope with the claims. The testing of a single type of mixture does not establish the criticality of mixtures within the realm of the claims wherein the (A-1) monocyclic ether and/or (A-2) polycyclic ether of formula (1) is an epoxide ( $n = 0$ ) or a tetrahydrofurfuryl ( $n = 2$ ), and/or wherein the polyepoxide is a structurally distinct polymer from the tested epoxidized block copolymer such as the aromatic epoxy resins and alicyclic polyepoxides disclosed on page 13. Furthermore, the showings are not commensurate in scope with the claimed compatible solid resin (B) with a softening point of at least 40°C which embraces myriad species other than the described tackifiers.

Claims 1-5, 9, 10, 12, 14, 15, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Nos. 11-140279, 11-152441, 10-158581, 5-171083, 5-171084, 7-62082 and 7-53711 in view of Japanese Patent Nos. 9-40670 and 9-328651.

The rejections are maintained for the reasons of record set forth in the previous Office action. The arguments filed November 10, 2003 have been considered but are unpersuasive.

The viscoelastic properties represented by the four relationships in independent claims 1 and 20 are inherent in the formulations of the Japanese patents based on the equivalent mono-oxetane or monoepoxide admixed with a polyepoxide or polyoxetane and cationic polymerization initiator within the claimed limits set forth in the primary Japanese patents.

The comparison between Example 1 and Comparative Example 1 is unconvincing for the reasons espoused hereinabove.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

(571) 272-1093 (Fax no. (703) 872-9306)  
Monday to Friday from 9:30 to 6:00 EST



Robert Sellers  
Primary Examiner  
Art Unit 1712

rs  
12/29/03